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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/457,796	12/09/1999	GREGORY MATHUS	5044	8079

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EXAMINER

BEX, PATRICIA K

ART UNIT PAPER NUMBER

1743

11

DATE MAILED: 08/28/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/457,796

Applicant(s)

MATHUS ET AL.

Examiner

P. Kathryn Bex

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-5 and 10-28 is/are pending in the application.
- 4a) Of the above claim(s) 16-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-5, 10 and 26-28 is/are rejected.
- 7) ☒ Claim(s) 11-15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 December 0999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 20, 2002 has been entered.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "second opening" in claim 26 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: "second openings" in claim 26.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 26-28, 2-5, 10-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 26, line 8, the recitation of the notches in the side walls “having downwardly facing second openings” is confusing and indefinite. The term “notch” is known and accepted within the art to include a V- shaped opening. The limitation of the “notch having a downward facing second opening” appears to be redundant. How does the *second openings* differ from *notch* #52, 54? Moreover, the recitation on line 8 of the claim, “notches *and* the second openings being defined by surfaces” creates confusion and uncertainty as to what Applicant is trying to claim. Only the “notches” are disclosed as having a “trunnion travel surface” #56, see page 6, lines 9-10 and Fig. 5.

Line 9, now recites “said notches and said second opening defined by surfaces that coact with said trunnions to *alternatively* accommodate (i) unimpeded vertical movement of said cover between said closed position and a raise position removed from the base, and (ii) limited rotation of said cover about said trunnions between said closed position and an inclined open position providing access to said tube-receiving openings”, the use of alternative expressions are permitted if they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims. One acceptable form of alternative expression, which is commonly referred to as a Markush group, recites members as being “selected from the group consisting of A, B and C.” See *Ex parte Markush*, 1925 C.D. 126 (Comm’r Pat. 1925). The way the claim is currently written, the cover need only be configured to coact with the trunnions to either accommodate (i) unimpeded vertical movement of said cover between said closed position

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and a raise position removed from the base or (ii) limited rotation of said cover about said trunnions between said closed position and an inclined open position providing access to said tube-receiving openings.

Claim 27, "downwardly facing openings" should be changed to --second openings--, for clarity.

Claim 2, "said openings" should be changed to --said first opening--. Same deficiency was found in claims 3-5.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 26-28, 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laska (USP 5,993,745) in view of Corsi *et al* (USP 4,942,271) or Aiken (USP 6,138,863).

Laska teaches a storage assembly for holding multiple test tubes 56, 59 of varying heights

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and diameters. The assembly comprising a base and a transparent cover portion. The base comprising a plurality of openings 25, wherein a plurality of projecting support pads 30 A-D, 60 A-D are symmetrically positioned within the openings. Moreover, the pads comprise a surface 31 A-D, 61 A-D which engages the test tubes (Figs. 1A- 6A). However, Laska does not disclose the use of a rotatable and removable cover comprising a notch, wherein the notch includes a trunnion travel surface and a ledge surface, or a base comprising a trunnion.

Corsi *et al* do teach the use of a rotatable and removable cover. The cover comprising a notch, wherein the notch includes a trunnion travel surface 166, 260 and a ledge surface 162 and a base 114, 214 comprising a corresponding trunnion 120, 220. Additionally, Corsi *et al* do teach a latching means for securing the cover to the base (Figs. 1-13). Such a hinge system can be easily manufactured and does not require numerous parts.

Similarly, Aiken teaches a multipurpose container having a cover and receptacle. The receptacle has a base, side and end walls. Additionally, the base comprises a plurality of slots or openings 110 therein. The container has a removable lid 120 with a notch 32 formed at the bottom surface of the lid. The notch including a surface which rotates around a trunnion 30, 36. The notch further comprising a ledge surface 40 (Figs. 4-8). Note: process limitations, i.e. the limitations describing the movement of the lid around the trunnion, have not been given any patentable weight, since process limitations are not accorded patentable weight in a claim which is directed to an apparatus. Aiken does teach the lid can be disengaged from the receptacle 14 by pulling the lid in a direction away from the cylindrical trunnion 36 until the notches 32 release the trunnion (column 5, lines 10-13). Although, Aiken does not specially recite the unimpeded vertical movement of the cover from the container, it would have been an obvious matter of

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design choice to have only include the downward facing notches such that the lid maybe removed vertically, since applicant has not disclosed that vertical removal of the lid solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with method of removal taught by Aiken.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to have included in the test tube storage assembly of Laska the hinge system, as taught by Corsi *et al* or Aiken, in order to provide a hinge system which can be easily manufactured and does not require numerous parts (column 1, lines 24-45, Corsi *et al*).

Regarding the shape of the openings, it would have been an obvious matter of design choice to have made the shape of the openings in the base of Laska rectangular. Moreover, since applicant has not disclosed that rectangular openings solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with circular openings. This same reasoning applies to the shape of the surface pads.

9. Claims 26-28, 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laska (USP 5,993,745) in view of Hawk (USP 3,860,141) or Yuhara (USP 6,138,686).

Laska teaches a storage assembly for holding multiple test tubes 56, 59 of varying heights and diameters. The assembly comprising a base and a transparent cover portion. The base comprising a plurality of openings 25, wherein a plurality of projecting support pads 30 A-D, 60 A-D are symmetrically positioned within the openings. Moreover, the pads comprise a surface 31 A-D, 61 A-D which engages the test tubes (Figs.1A- 6A). However, Laska does not disclose the use of a rotatable and removable cover comprising a notch, wherein the notch includes a trunnion travel surface and a ledge surface, or a base comprising a trunnion.

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Hawk does teach the use of a rotatable and removable cover 10. The cover comprising a notch 23, 36 wherein the notch includes a trunnion travel surface which engages the container trunnion 12, 37, wherein lateral displacement is prevented by engagement of the flange 16. Additionally, the cover is readily assembled with the container 11 as the cover is simply placed vertically downward onto the container trunnion 12 (column 3, lines 12-18). Such a self-hinging system is advantageous since fixed hinge mechanisms are known to be relatively costly to fabricate and when made from molded plastic, are very susceptible to breakage (column 1, lines 15-25).

Similarly, Yuhara teaches numerous embodiments of a container having a cover 72 and receptacle 48. The receptacle has a base, side and end walls (Fig. 25). The container has a lid 72 with a notch 76 formed at the bottom surface of the lid. The notch including a surface which pivotably connects to trunnion 66. Yuhara does teach a latching means 74, 54 for securing the cover to the base (Figs. 1-13) (column 10, lines 13-50). Note: the notch 76 does not have any obstructions and therefore the cover 72 is capable of being vertically removed from the trunnion 66. Additionally, process limitations, i.e. the limitations describing the movement of the lid around the trunnion, have not been given any patentable weight, since process limitations are not accorded patentable weight in a claim which is directed to an apparatus.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to have included in the test tube storage assembly of Laska the hinge system, as taught by Hawk or Yuhara, in order to provide a hinge system which can be easily manufactured and does not break easily (column 1, lines 15-25, Hawk).

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Regarding the shape of the openings, it would have been an obvious matter of design choice to have made the shape of the openings in the base of Laska rectangular. Moreover, since applicant has not disclosed that rectangular openings solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with circular openings. This same reasoning applies to the shape of the surface pads.

10. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Laska (USP 5,993,745) and Corsi *et al* (USP 4,942,271) or Aiken (USP 6,138,863) as applied to claim 26, and further in view of Berry, Jr. (USP 5,415,846).

Laska, Corsi *et al*, and Aiken as discussed above, do not teach the specific use of slide latches to secure the cover to the base. Berry, Jr. does teach two slide latch mechanisms 49 designed for securing the lid 22 to the tray 21. The base comprising first and second base sidewalls 25, 26 each having a slide surface having a lengthwise groove 31 which mates with a lengthwise tongue 58 of the slide latch (Figs. 1-3, 6-7). Note: lengthwise has been interpreted to mean along the direction of length of the respective elements, wherein these elements not necessarily the same direction.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to have included in the system of Laska, Corsi *et al* and Aiken, the securing mechanism of Berry, Jr. in order to provide a quiet smooth and convenient latch design (column 2, lines 30-34).

11. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Laska (USP 5,993,745) and Hawk (USP 3,860,141) or Yuhara (USP 6,138,686) as applied to claim 26, and further in view of Berry, Jr. (USP 5,415,846).

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Laska, Hawk, and Yuhara as discussed above, do not teach the specific use of slide latches to secure the cover to the base. Berry, Jr. does teach two slide latch mechanisms 49 designed for securing the lid 22 to the tray 21. The base comprising first and second base sidewalls 25, 26 each having a slide surface having a lengthwise groove 31 which mates with a lengthwise tongue 58 of the slide latch (Figs. 1-3, 6-7). Note: lengthwise has been interpreted to mean along the direction of length of the respective elements, wherein these elements not necessarily the same direction.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to have included in the system of Laska, Hawk and Yuhara, the securing mechanism of Berry, Jr. in order to provide a quiet smooth and convenient latch design (column 2, lines 30-34).

Allowable Subject Matter

12. Claims 11-15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

13. The following is a statement of reasons for the indication of allowable subject matter: see previous Office Action.

Response to Arguments

14. Applicant's arguments filed June 20, 2002 amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Examiner contends that the cited references

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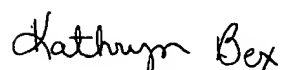
Aiken (USP 6,138,863) and Corsi *et al* (USP 4,942,271) do suggest vertical separation of the cover from the base. For example, Corsi *et al* teach a base and cover which are adapted to be releasably and pivotally coupled together to enclose conduits therein (column 2, lines 57-59). Moreover, the embodiment of Corsi *et al* in Figures 10-11 show the notch 260 larger than the maximum transverse dimension of the trunnion 220.

Conclusion

15. No claims allowed.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Kathryn Bex whose telephone number is (703) 306-5697. The examiner can normally be reached on Mondays-Thursdays, alternate Fridays from 6:00 am to 3:30 pm EST.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.



P. Kathryn Bex
Patent Examiner
AU 1743
August 22, 2002



Jill Warden
Supervisory Patent Examiner
Technology Center 1700